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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,842	07/22/2003	Robert Lance Cook	25791.151	7856

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HAYNES AND BOONE, LLP
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EXAMINER

BOMAR, THOMAS S

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/624,842

Applicant(s)

COOK ET AL.

Examiner

Shane Bomar

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☒ Claim(s) 56-59 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11 total.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 38, 40, 41, 51, and 55 are objected to because of the following informalities: the recitation of "the region" in claim 38 lacks antecedent basis in claim 25, although it is noted that claim 37 provides basis for this limitation; claims 40 and 41 are exact duplicates of claims 19 and 20 and appear to be unnecessary; in claim 51, it is unclear whether the recitation of "a mandrel" is in addition to the mandrel recited in claim 50 or if it is a new mandrel; the recitation of "The wellhead" in claim 55 should most likely be --The apparatus--. Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 3-9, and 50-55 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 10-16 of U.S. Patent No. 6,739,392. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 3 of the instant application disclose a wellhead or an

Art Unit: 3672

apparatus that comprises an outer casing (or tubular member) at least partially positioned within a wellbore; and a plurality of inner casings (or tubular members) coupled to the interior surface of the outer casing by the process of expanding each (or, one or more) of the inner casings into contact with at least a portion of the interior surface of the outer casing; and wherein adjacent inner casings define an annulus therebetween. The only difference between these limitations and the limitations in claim 10 of the '392 patent is that the inner casings (or tubular members) are substantially concentric and only an end portion of the inner casing is expanded. It would have been obvious to one of ordinary skill in the art at the time the invention was made that the plurality of inner casings (or tubular members) of the instant application coupled to the interior surface of an outer casing could be concentric as is known, and that the process of expanding each (or, one or more) of the inner casings into contact with at least a portion of the interior surface of the outer casing would be encompassed by the process of expanding an end portion of one or more of the inner casings with at least a portion of the interior surface of the outer casing. Furthermore, all of the limitations disclosed in the claims dependent from claims 1 and 3 are also disclosed by the claims depending from claim 10 in the '392 patent.

4. Claims 2 and 10-49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,640,903. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 2 of the instant application discloses a method of forming a wellhead that comprises drilling a wellbore; positioning an outer casing at least partially within an upper portion of the wellbore; positioning a first tubular member within the outer casing; expanding at least a portion of the first tubular member into contact with an interior surface of the outer casing; positioning a

Art Unit: 3672

second tubular member within the outer casing and the first tubular member; and expanding at least a portion of the second tubular member into contact with an interior portion of the outer casing; wherein the first and second tubular members define an annulus therebetween. Claim 1 of the '903 patent discloses all of these limitations except that it contains one more limitation wherein at least a portion of the second tubular is positioned within the first tubular member after the portions are expanded. It would have been obvious to one of ordinary skill in the art at the time the invention was made that, after expanding the portions of the first and second tubulars, that at least a portion of the second tubular of the instant application would be positioned within the first tubular member since the second tubular was already positioned within the first tubular in a previous step. Furthermore, all of the limitations of the claims that depend from claim 2 are disclosed by the claims that depend from claim 1 of the '903 patent or its associated specification.

Allowable Subject Matter

5. Claims 56-59 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Maguire et al teach an apparatus comprising an outer tubular member 105, and a plurality of inner tubular members 150 and 200 coupled to the interior surface of the outer tubular member 105 by the process of expanding one or more of the inner tubular members into

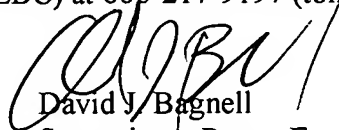
Art Unit: 3672

contact with at least a portion of the interior surface of the outer tubular member (see Figs. 4c-4e), wherein adjacent inner tubular members define an annulus therebetween (see col. 4, lines 53-55 where it is stated that the unexpandable portion 210 could be the lower portion, which would then be inside of the tubular 150 and would therefore have an annulus between members 150 and 200). However, the filing date of this patent precludes it as prior art.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shane Bomar whose telephone number is 703-305-4849. The examiner can normally be reached on Monday - Thursday from 7:00am to 4:30pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 703-308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David J. Bagnell
Supervisory Patent Examiner
Art Unit 3672

tsb


August 18, 2004